

REMARKS

This is a response to the Office Action dated August 29, 2003. Claims 21 and 37 have been amended. Claims 21-49 are currently pending in the present application.

The Examiner's indication that claims 35-36 and 45-56 would be allowable if rewritten in independent form is hereby acknowledged with appreciation.

The Examiner has objected to the drawings under 37 C.F.R. §1.83(a) on the basis that the drawings do not show the forefoot region of the sole. This objection is respectfully traversed on the basis that Figures 15A and 15D show the forefoot region of the sole. See e.g. page 14, line 28 and page 15, lines 10-12 of the application as originally filed. Favorable consideration and withdrawal of the objection is requested.

Claims 21-49 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification as originally filed. Specifically, the Examiner objected to the claim limitations requiring the "sole forefoot area" and the "sole midtarsal area" on the basis that these areas of the shoe sole are not described in the specification as originally filed. This rejection is respectfully traversed on the basis that Figs. 15A and 15D show the sole forefoot area, and Figs. 15B and 15E show the sole midtarsal area. These portions of the sole are mentioned on pages 14-15 of the application as originally filed. Favorable consideration and withdrawal of the rejection are requested.

Claims 21-49 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite on the basis that the "sole forefoot area" and the "sole midtarsal area" are not clearly shown in the figures or described in the specification. This rejection is respectfully traversed on the basis that Figs. 15A and 15D show the sole forefoot area, and Figs. 15B and 15E show the sole midtarsal area. These portions of the sole are mentioned on pages 14-15 of the application as originally filed. Favorable consideration and withdrawal of the rejection are requested.

Claim 21 has been rejected as failing to provide proper antecedent basis for the phrases, "the convexly rounded portion of the sole inner surface" and "the concavely rounded portion of the sole outer surface." Claim 21 has been amended to refer to "the convexly rounded portion of the inner midsole surface" and "the concavely rounded portion of the outer midsole surface" in order to provide proper antecedent basis for the

claim terminology. Favorable consideration and withdrawal of the rejection in view of these amendments is requested.

Claim 37 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite on the basis that it contains the phrase, "increases gradually from a thickness at an uppermost point of each of said upper portions of the midsole part to a lesser thickness at a location below the uppermost point." Claim 37 has been amended to replace "lesser" with "greater in order to overcome this rejection. Favorable consideration and withdrawal of the rejection are requested.

Claim 39 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite on the basis that it locates the frontal plane cross-section in the forefoot area of the shoe sole. Figs. 15A and 15D show frontal plane cross-sections in the forefoot area of the shoe sole and thus this limitation has been defined in the specification. Favorable consideration and withdrawal of the rejection are requested.

Claims 21-49 have been rejected under 35 U.S.C. §103(a) as being obvious over a combination of Japanese reference no. 39-15597 (hereinafter "JP '597") in view of U.S. Patent no. 4,370,402 (hereinafter "Norton '402"). This rejection, at least insofar as it applies to claims 21-49, is respectfully traversed and reconsideration is requested for the reasons which follow.

Applicant respectfully submits that the Official Action does not set forth a *prima facie* case of obviousness in support of the rejection under 35 U.S.C. § 103(a).

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.**

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. [*Citation omitted; emphasis supplied.*]

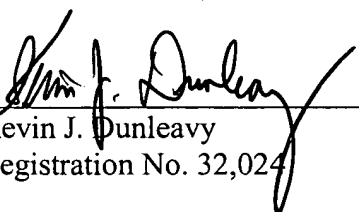
Each of Applicant's claims 21-49, as amended, requires a portion of a midsole side located between the convexly rounded portion of the inner midsole surface and the concavely rounded portion of the outer midsole surface having a thickness that is greater than a least thickness of the midsole in the sole middle portion. No matter which layer of the shoe sole of JP '597 the Examiner deems to be the midsole, none of the layers has a midsole side portion having a greater thickness than the least thickness of the midsole in the sole middle portion, as shown in Fig. 7 of JP '597. The embodiments of Norton '402 also do not show this feature. Thus, since a feature of all of claims 21-49, as amended, is missing from both references relied upon by the Examiner, it is considered that the rejection should be withdrawn on the basis that it does not make out a case of *prima facie* obviousness.

For the record, the applicant does not agree with the Examiner's interpretation of Fig. 7 of JP '597, particularly since JP '597 does not even mention the presence of a midsole in its specification. For the Examiner's convenience, an enlarged Fig. 7 of JP '597 is enclosed. It is submitted that a skilled person, reading the specification of JP '597, is capable of determining which element is which in Fig. 7 of JP '597 using this enlarged version of Fig. 7.

Favorable consideration, withdrawal of the rejections and issuance of a Notice of Allowance, are requested.

Respectfully submitted,

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